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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/447,886 11/24/99 OISHI

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IM62/0605

EXAMINER

PILLSBURY MADISON & SUTRO LLP
INTELLECTUAL PROPERTY GROUP
1100 NEW YORK AVENUE N W
NINTH FLOOR EAST TOWER
WASHINGTON DC 20005-3918

LAMB, B

ART UNIT

PAPER NUMBER

1734

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	09/447,886	Applicant(s)	Oishi et al
Examiner	Lamb	Group Art Unit	1784

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on 3/13/00
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1-9 is/are pending in the application.
- Of the above claim(s) 1-2 is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 3-4 is/are rejected.
- Claim(s) 5-9 is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 112 and 5 Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948. Other _____

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DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, drawn to method, classified in class 427, subclass 163.2.
- II. Claims 3-9, drawn to apparatus, classified in class 118, subclass 420.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as coating a metal wire.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Perry on 7/19/00 a provisional election was made with traverse to prosecute the invention of Group II, claims 3-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-2 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor 4,474,830.

Taylor teaches design of an optical fiber coating apparatus comprised of the following elements: a first coating die having a first die hole, a lower end face and a protrusion formed

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around the first die hole such that fiber traveling through the first die hole is coated by a first coating resin which is injected in the space formed between the first die hole and the outer periphery of the fiber; a second coating die having a second die hole concentric with the first die hole, an upper end face which opposes the lower end face of the first coating die so as to form a gap through which the second coating resin is injected into a space between the second die hole and fiber. Taylor fails to teach that the lower end face of the first die is disk shaped and upper end face of the second coating die is circular. However, it would have been obvious matter of design choice to design the lower end face of the first die such that it is disk-shaped and upper end face of the second die such that it is circular since such a modification would have involved a mere change in the shape of a component absent persuasive evidence that the particular configuration of the claimed above cited elements was significant (In re Dailey ,149 USPQ 47 (CCPA 1966)). Taylor fails to teach the protrusion reduces an annular lower-pressure region formed around the fiber in the gap. However, it would have been obvious that the Taylor protrusion would have reduced the annular lower pressure region around the fiber in the gap in order to substantially eliminate recirculation of the second coating liquid in the vicinity of the fiber and especially since the physical presence of the protrusion itself would have reduced the total area of the gap. With respect to claim 4, Taylor fails to teach the shape of protrusion is a circular truncated cone. However, it would have been an obvious matter of design choice to design the protrusion such that it is a circular truncated cone since such a modification would have involved a mere change in

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the shape of a component absent persuasive evidence that the particular configuration of the claimed element was significant (In re Dailey ,149 USPQ 47 (CCPA 1966)).

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 09241042.

Japan '042 teaches design of an optical fiber coating apparatus comprised of the following elements: a first coating die having a first die hole, a disk shaped lower end face and a protrusion formed around the first die hole such that fiber traveling through the first die hole is coated by a first coating resin which is injected in the space formed between the first die hole and the outer periphery of the fiber; a second coating die having a second die hole concentric with the first die hole, a circular upper end face which, opposes the lower end face of the first coating die so as to form a gap through which the second coating resin is injected into a space between the second die hole and fiber. Japan '042 fails to teach the protrusion reduces an annular lower-pressure region formed around the fiber in the gap. However, it would have been obvious that the Japan '042 protrusion would have reduced the annular lower pressure region around the fiber in the gap in order to substantially eliminate recirculation of the second coating liquid in the vicinity of the fiber and especially since the physical presence of the protrusion itself would have reduced the total area of the gap. With respect to claim 4, Japan '042 fails to teach the protrusion has a circular truncated cone shape. However, it would have been an obvious matter of design choice to design the Japan '042 protrusion such that it is a circular truncated cone since such a modification would have involved a mere change in the shape of a component absent persuasive evidence that the

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particular configuration of the claimed element was significant (In re Dailey, 149 USPQ 47 (CCPA 1966)).

Claims 5-9 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Brenda A. Lamb at telephone number (703) 308-2056.

Brenda A. Lamb
BRENDA A. LAMB
PRIMARY EXAMINER

Lamb/af

May 11, 2001